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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,028	10/03/2003	Daniel R. Malone	03-021	1498

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EXAMINER
DEBROW, JAMES J

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/679,028	MALONE ET AL.
	Examiner	Art Unit	
	James J. Debrow	2176	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>03 October 2003</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-13</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-13</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>03 October 2003</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

        1. ☐ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. _____.

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>1/7/2005</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communication: Application filled on 03 Oct. 2003.

2.   Claims 1-13 are pending in this case. Claims 1, 8, 11, and 13 are independent

claims.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 8, 11, 12 and 13 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter. The claimed invention is

considered functional descriptive material (software), per se, which is not statutory.

Functional descriptive material claimed in combination with an appropriate

computer readable medium to enable the functionality to be realized is patent eligible

subject matter if it is capable of producing a useful, concrete, and tangible result when

used in a computer system.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

5.   **Claim 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over**

Friedman et al. (Pub. No.: US 2003/0208556 A1; Filling Date: Oct. 18, 1999)

(hereinafter 'Friedman'), in view of Fuwa et al. (Pub. No.: US 2005/0102151 A1;

Filling Date: Dec. 25, 2001) (hereinafter 'Fuwa').

In regard to independent claim 1, Friedman discloses *a computer-implemented*

electronic product template method comprising

receiving a user request to initiate a product design session using a selected

template (0014, lines 1-7; Friedman discloses the user may selects any of a number of

card templates stored in a database.)

displaying the selected template to the user (0014, lines 7-8),

providing one or more tools allowing the user to change at least one component

element of the template (0014, lines 9-12; 0015, lines 10-11; Friedman discloses the

user is able to customize the card by adding text, handwritten notes, graphics,

photographs and scanned data to the card.), *and*

in response to each user change of a component element, associating the

element identifier of the new component element with the product description identifier

and modifying the displayed template to reflect the change (0019, lines 1-9; Friedman

teaches the modification to the card is viewed in a WYSIWYG format. It has been

established and is well known to a person of ordinary skill in the art that the WYSIWYG

format would allow the user to immediately view the modifications to the card as they

are made.)

Friedman does not disclose expressly *associating a product description identifier*

with a plurality of component element identifiers, each component element identifier

identifying a component element of the selected template.

However, Fuwa teaches *associating a product description identifier with a*

plurality of component element identifiers, each component element identifier

identifying a component element of the selected template (0038 – 0039; Fuwa teaches

how products are classified into broad categories *(product description identifier)*, and

each category is classified into sub-categories *(component element identifier)*.).

Therefore, at the time of the invention, it would have been obvious to a person of

ordinary skill in the art to combine Friedman with Fuwa for the benefit of associating a

product description identifier (product categories) with component element identifiers

(product sub-categories).

In regard to dependent claim 2, Friedman does not disclose expressly *the method of claim 1 further comprising*

using at least some of the element identifiers associated with the product description identifier as element identifiers of a different template, and displaying the different template to the user.

However, Fuwa teaches *using at least some of the element identifiers associated with the product description identifier as element identifiers of a different template, and displaying the different template to the user* (0038; Fig. 2; 0044; Fig. 3; Fuwa teaches/illustrates how sub-categories *(element identifiers)* of one template can be used as a sub-category on a different template.).

Therefore, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Friedman with Fuwa for the benefit of associating a product description identifier (product categories) with component element identifiers (product sub-categories).

In regard to dependent claim 3, Friedman discloses *the method of claim 2 wherein the different template is template for a different side of the same product currently being designed by the user* (0074; 0086, lines 7-14; Fig 6B; Friedman illustrates three different panel(sides) of a card in which the user can click on any panel and selected panel will be displayed in an editable format.).

In regard to dependent claim 4, Friedman discloses *the method of claim 2 wherein the different template is a template for a different product* (0094-0096; Friedman teaches that once changes to the card are accepted, the system automatically presents the user a different web page (template) to specify information related to the recipient. Friedman further teaches the user is provided a summary web page (template), which the user can edit any information or add or delete the card.).

In regard to dependent claim 5, Friedman discloses *the method of claim 4 wherein the template for the different product is created without user request* (0094-0096; Friedman teaches that once changes to the card are accepted, the system automatically presents the user a different web page (template) to specify information related to the recipient. Friedman further teaches the user is provided a summary web page (template), which the user can edit any information or add or delete the card.).

In regard to dependent claim 6, Friedman discloses *the method of claim 5 wherein the template for the different product is displayed to the user without user request* (0094-0096; Friedman teaches that once changes to the card are accepted, the system automatically presents the user a different web page (template) to specify information related to the recipient. Friedman further teaches the user is provided a summary web page (template), which the user can edit any information or add or delete the card.).

In regard to dependent claim 7, Friedman discloses *the method of claim 5*

further comprising providing a means whereby the user can initiate an order for the

production of the different product (0099; Friedman teaches how a credit card

transaction is used to produce and ship the order to the user.).

In regard to independent claim 8, Friedman discloses *a computer-implemented*

electronic product template method comprising (0126)

receiving a user request to initiate a product design session using a selected

template (0014, lines 1-7; Friedman discloses the user may selects any of a number of

card templates stored in a database.),

displaying the selected template to the user (0014, lines 7-8),

in response to user selection of one of the earlier product identifiers, associating

at least one of the component element identifiers of the selected earlier product with

the product description identifier and modifying the displayed template to reflect the

change (0019, lines 1-9; Friedman teaches the modification to the card is viewed in a

WYSIWYG format. It has been established and is well known to a person of ordinary

skill in the art that the WYSIWYG format would allow the user to immediately view the

modifications to the card as they are made.)

Friedman does not disclose expressly *associating a product description identifier with a plurality of component element identifiers, each component element identifier identifying a component element of the selected template.*

displaying identifiers associated with one or more earlier products associated with the user, and

However, Fuwa teaches *associating a product description identifier with a plurality of component element identifiers, each component element identifier identifying a component element of the selected template* (0038 – 0039; Fuwa teaches how products are classified into broad categories *(product description identifier)*, and each category is classified into sub-categories *(component element identifier).).*

displaying identifiers associated with one or more earlier products associated with the user (0041-0042; Fuwa teaches the customer management database stores information about customers who has order in the past, and the orders management database stores information about the each order number and information about orders.), *and*

Therefore, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Friedman with Fuwa for the benefit of associating a product description identifier (product categories) with component element identifiers (product sub-categories).

In regard to dependent claim 9, Friedman discloses *the method of claim 8*

wherein the earlier product identifiers are thumbnail images of at least a portion of the

earlier products (0072; 0086; Fig. 6A; Friedman teaches to facilitate selection and

customization, card may be stored in a database as files in a thumbnail, intermediate

and editable size.).

In regard to dependent claim 10, Friedman discloses *the method of claim 8*

wherein the earlier product identifiers are displayed in response to a user request

(0086; Friedman teaches the user can select a card by clicking on the appropriate

thumbnail image of the card.).

In regard to independent claim 11, Friedman discloses *a computer program*

comprising computer code (0126) *adapted to*

receive a user request to initiate a product design session using a selected

template (0014, lines 1-7; Friedman discloses the user may selects any of a number of

card templates stored in a database.),

display the selected template to the user (0014, lines 7-8),

provide one or more tools allowing the user to change at least one component

element of the template (0014, lines 9-12; 0015, lines 10-11; Friedman discloses the

user is able to customize the card by adding text, handwritten notes, graphics,

photographs and scanned data to the card.), *and*

in response to each user change of a component element, associate the element

identifier of the new component element with the product description identifier and

modify the displayed template to reflect the change (0019, lines 1-9; Friedman teaches

the modification to the card is viewed in a WYSIWYG format. It has been established

and is well known to a person of ordinary skill in the art that the WYSIWYG format

would allow the user to immediately view the modifications to the card as they are

made.).

Friedman does not disclose expressly *associating a product description identifier*

with a plurality of component element identifiers, each component element identifier

identifying a component element of the selected template.

However, Fuwa teaches *associating a product description identifier with a*

plurality of component element identifiers, each component element identifier

identifying a component element of the selected template (0038 – 0039; Fuwa teaches

how products are classified into broad categories *(product description identifier)*, and

each category is classified into sub-categories *(component element identifier).*).

Therefore, at the time of the invention, it would have been obvious to a person of

ordinary skill in the art to combine Friedman with Fuwa for the benefit of associating a

product description identifier (product categories) with component element identifiers

(product sub-categories).

In regard to dependent claim 12, Friedman does not disclose expressly the *computer program of claim 11 further comprising computer code adapted to use at least some of the element identifiers associated with the product description identifier as element identifiers of a different template and display the different template to the user.*

However, Fuwa teaches the *computer program of claim 11 further comprising computer code* (0127) *adapted to use at least some of the element identifiers associated with the product description identifier as element identifiers of a different template and display the different template to the user* (0038; Fig. 2; 0044; Fig. 3; Fuwa teaches/illustrates how sub-categories *(element identifiers)* of one template can be used as a sub-category on a different template.).

Therefore, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Friedman with Fuwa for the benefit of associating a product description identifier (product categories) with component element identifiers (product sub-categories).

In regard to independent claim 13, Friedman discloses *a computer program comprising computer code* (0126) *adapted to*

receive a user request to initiate a product design session using a selected

template (0014, lines 1-7; Friedman discloses the user may selects any of a number of

card templates stored in a database.),

display the selected template to the user (0014, lines 7-8),

in response to user selection of one of the earlier product identifiers, associate at

least one of the component element identifiers of the selected earlier product with the

product description identifier and modifying the displayed template to reflect the

change (0019, lines 1-9; Friedman teaches the modification to the card is viewed in a

WYSIWYG format. It has been established and is well known to a person of ordinary

skill in the art that the WYSIWYG format would allow the user to immediately view the

modifications to the card as they are made.).

Friedman does not disclose expressly *associating a product description identifier*

with a plurality of component element identifiers, each component element identifier

identifying a component element of the selected template.

displaying identifiers associated with one or more earlier products associated

with the user, and

However, Fuwa teaches *associating a product description identifier with a*

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how products are classified into broad categories *(product description identifier)*, and

each category is classified into sub-categories *(component element identifier).).*

displaying identifiers associated with one or more earlier products associated

with the user (0041-0042; Fuwa teaches the customer management database stores

information about customers who has order in the past, and the orders management

database stores information about the each order number and information about

orders.)*, and*

Therefore, at the time of the invention, it would have been obvious to a person of

ordinary skill in the art to combine Friedman with Fuwa for the benefit of associating a

product description identifier (product categories) with component element identifiers

(product sub-categories).

Conclusion

Any inquiry concerning this communication or earlier communications from the
examiner should be directed to James J. Debrow whose telephone number is 571-272-
5768. The examiner can normally be reached on 8:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number
for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the
Patent Application Information Retrieval (PAIR) system. Status information for
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you have questions on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free).

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